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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/765,391 | 01/28/2004 | Anthony Di Bitonto | B0224.0079 | 2535 |
| 32172 | 7590 | 12/02/2005 | EXAMINER | |
| DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) 41 ST FL. NEW YORK, NY 10036-2714 | | | NGUYEN, PHONG H | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3724 | |

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,391

Applicant(s)

DI BITONTO ET AL.

Examiner

Phong H. Nguyen

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3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2-4 and 9-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 5-8 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06/24/2005.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

-The post extends from the top surface of the bottom member to a point above the top surface of the top member in claims 1, 16 and 17.

-The second post in claim 18.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.81 because Fig. 6 does not appear to be a top view of Fig. 5. The cutting edges in Fig. 5 appear to be similar to those in Fig. 4. Therefore, it is unclear how the cutting edge 113 in Fig. 6 is disposed at an angle with respect to the central longitudinal axis of the top and the bottom member as shown in Fig. 6.

A perspective drawing of Fig. 5 is needed for better understanding the invention.

3. The drawings are objected to because of the shaded area in Fig. 4. Applicant is advised to remove the shaded area for better presenting the structure of the invention. See examples in Figs. 1-3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the

examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The Specification is objected to under 37 CFR 1.71 because it does not clearly describe the structure of the clipper in Fig. 5 which Applicant claims as his invention.

- As shown in Fig. 5, the top member and the bottom member are not interconnected by a post as claimed and there is no post extending from the top surface of the bottom member to a point above the top surface of the top member as describes in claim 1.

-It is unclear how the post in claim 1, the second post in claim 18, the top member and the bottom member interact with each other.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 5-8 and 16-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 1, it appears that the clipper in Fig. 5 does not have a post for connecting the top member and the bottom member. Merely adding a label to Fig. 5 is not enough to describe the invention.

Regarding claim 18, it is unclear how the post in claim 1, the second post in claim 18, the top member and the bottom member interact with each other during a nail cutting process.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 5-8 and 16-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether the Applicant claims the triangle shaped bumpers being provided on the nail clipper in Fig. 4 or Fig. 5. There is no indication in the Specification that the triangle shaped bumpers can be used in the nail clipper in Fig. 4. The allowability cannot be commented on at this time in view of the issues under 37 CFR 1.71 and 35 USC 112.

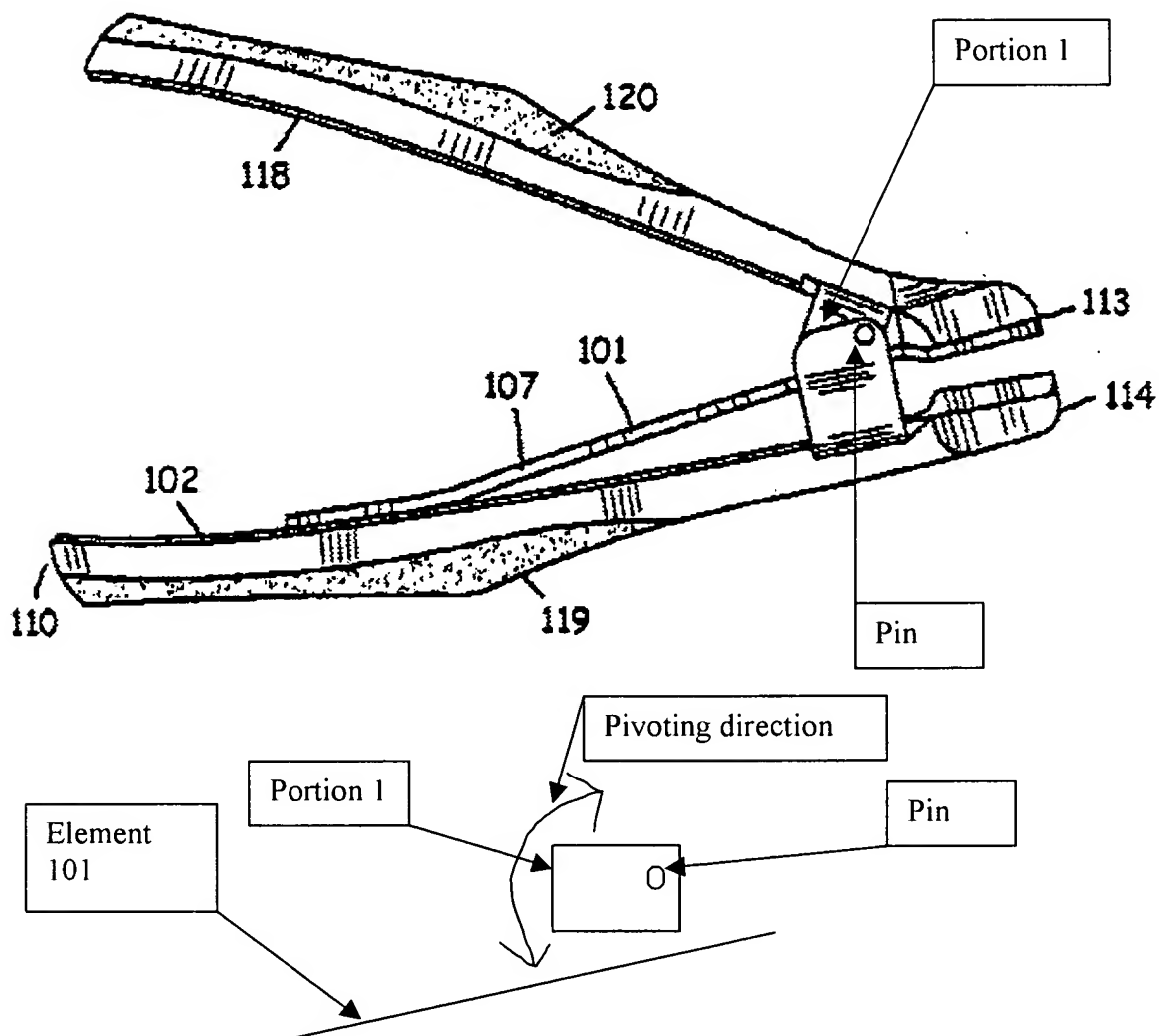
Response to Arguments

9. Applicant's arguments filed 09/23/2005 have been fully considered but they are not persuasive.

Regarding Applicant's argument with respect to the drawings, merely adding a label 117 to Fig. 5 does not overcome the drawing objection with respect to claim 1. The

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corrected Fig. 5 does not show the post extending above the top surface of the top member. It appears that the nail clipper in Fig. 5 can function without the post. For example, portion 1 pivots about a pin to press down the top member. See below Figure and sketch. Therefore, more clarification of Fig. 5 is needed.



Regarding Applicant's argument with respect to the Specification, the structure of Fig. 5 is not clearly described the nail clipper as asserted. The limitation of the post

extending to above the top surface of the top member is not described in the Specification. The Specification only describes the structure in Fig. 4. As shown above, Fig. 5 could read on a different nail clipper structure. Therefore, objection to the Specification is proper.

Regarding Applicant's argument with respect to the rejection under 35 USC 112, 1st paragraph, it is rejected based on the structure of the nail clipper but not on a particular embodiment as asserted by the Applicant.

Regarding Applicant's argument with respect to the rejection under 35 USC 112, 2nd paragraph, at least there are three issues that make the claim unclear: (1) since Applicant elects the bumper in Fig. 5 and claims it in the non-elected structure in Fig. 4, it makes the claim unclear; (2) it is unclear whether changing the shape of the lever of the nail clipper so that it can accommodate two different kinds of bumpers is within ordinary skill in the art; and (3) it is unclear whether moving the bumper from the cutting head as shown in Fig. 4 to the hand-gripping portion (a distance from the cutting head) as shown in Fig. 5 is within ordinary skill in the art.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

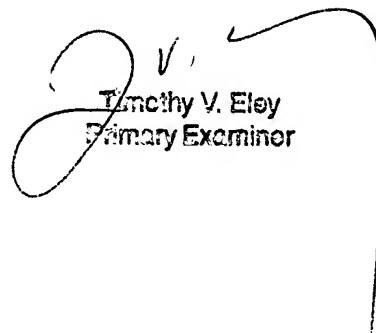
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phong H. Nguyen whose telephone number is 571-272-4510. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PN: 

November 29, 2005


Timothy V. Eley
Primary Examiner